

## REMARKS

This is responsive to the Final Office Action of February 3, 2006. Applicant respectfully submits that this amendment should be entered because it, Applicant believes, places the pending claims in condition for immediate allowance or removes issues for appeal.

### Status of Claims

Claim 11 is pending in this application and this claim has been rejected under 35 U.S.C., § 102(b).

### Rejection Under 35 USC § 102

Claim 11 has been rejected under 35 U.S.C. § 102(b) as being anticipated by Lipshutz et al. 1999, Nature Genetics Supplement, 21:20-24 ("Lipshutz") in light of Smith et al., U.S. Patent 6,372,249 ("Smith"). This rejection is respectfully traversed.

Applicant respectfully submits that Lipshutz fails to teach each of the limitations of Claim 11. See Applicant's arguments in the amendment filed with the Patent Office on November 30, 2005 in response to the Office Action of August 1, 2005, which arguments are incorporated herein by reference. Specifically, for example, Lipshutz fails to teach that the support substrate has fixation regions divided according to a classification based on gene functions and that classification is (1) to (9) as recited in Claim 11. Lipshutz focuses on whole genome oligonucleotide arrays containing genes from the human genome.

The Examiner admits that Lipshutz does not teach, expressly, all of the limitations of claim 11. In maintaining the rejection based on Lipshutz in light of Smith, however, the Examiner relies on "the theory of inherency" and contends that "the limitation of classifying multiple oligonucleotides according to their gene function is not drawn to a structural feature of the claimed array, but rather is drawn to a functional feature," and cites MPEP § 2114 and the case law therein. See pages 4-5 of the Office Action.

However, this contention completely ignores structural feature(s) explicitly recited in claim 11 and pointed to the Examiner by the Applicant in the amendment of November 30, 2005. The Examiner has not established, for example, that "the support substrate has fixation regions divided according to a [defined] classification . . .," which is a structural feature of the claimed array (and not a recitation of a new intended use as alleged by the Examiner) is "necessarily present," not merely or possibly present in the Lipshutz reference in light of

Smith. The Examiner cannot simply dismiss the explicitly recited structural features by stating that “[a] consideration of whether or not that a specific region occupied by a particular oligonucleotide occupies is further classified in accordance to a gene particular gene function does not serve to further limit the claimed array in a manner that materially effects the structure of the claimed apparatus.”

If the Examiner wishes to rely on the theory of inherency, then “the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 USPQ2d 1461 (Bd. Pat. App. & Inter. 1990). The Examiner has provided neither. The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531 (Fed. Cir. 1993).

As discussed above, the claimed oligonucleotide array is structurally distinguishable from the prior art as required by MPEP § 2114 and the case law relied upon by the Examiner at pages 4-5 of the Office Action.

In *In re Schreiber*, 128 F.3d 1473 (Fed. Cir. 1997), unlike the present case, the structural limitations recited in Schreiber's application were all found in the prior art reference (Harz reference) cited by the patent examiner. There, Schreiber argued that Harz did not disclose that such a structure could be used to dispense popcorn from an open-ended popcorn container. It was in that context, the Federal Circuit noted that “[i]t is well settled that the recitation of a new intended use for an old product does not make a claim to that old product patentable.”

*In re Swinehart*, 439 F.2d 210 (CCPA 1971), the court addressed the issue of whether the recitation of “functional” language in a claim renders the claim improper under 35 U.S.C., § 112. In pointing out the risks of defining an element functionally, i.e., by what it does, the court stated that “it is elementary that the mere recitation of a newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to those things to distinguish over the prior art.

*In re Danly*, 263 F.2d 844 (CCPA 1959), which concerned a patent claim that called for a press structure in which the tie rods were insulated from the frame and in which the construction was “such that alternating current may be passed through the tie rod to heat the same.” The court found that the quoted language did not constitute a structural limitation, since an alternating current may be passed through any tie rod which is insulated from the

press frame. It was in that context, the court noted that “[c]laims drawn to an apparatus must distinguish from the prior art in terms of structure rather than function.”

In *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464 (Fed. Cir. 1990), the patent claim (claim 1), in issue, concerned an X-Y plotter system for forming images on a web. The critical language was the last clause of claim 1: "wherein the rough surface ... has a random pattern, size, and height of rough spots." The court found the claim 1, reciting the quoted language to be an apparatus claim covering what a device is, not what a device does. *Bausch & Lomb* argued that the use of a "random pattern, size and height of rough spots" on the wheel does not provide any "operational difference" over a knurled wheel, and hence, this limitation in claim 1 does not render claim 1 unobvious over the prior art reference, Yeiser U.S. Patent No. Re 31,684. It was in that context, the court stated that “an invention need not operate differently than the prior art to be patentable, but need only be different.”

Nothing in the case law supports a rejection under anticipation when the claimed the product (oligonucleotide array) is structurally distinguishable from the cited prior art.

In view of the foregoing, Applicant respectfully submits that the Examiner has not established a *prima facie* case of anticipation. If the Examiner is aware of references which would tend to establish a *prima facie* case of anticipation, the Examiner is asked to cite them. If such facts are within the Examiner's personal knowledge, the Examiner is requested to make them part of the record by way of affidavit as required by 37 C.F.R. §1.104(d)(2). In the absence of such additional disclosures, the rejection under §102(b) is improper.

Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

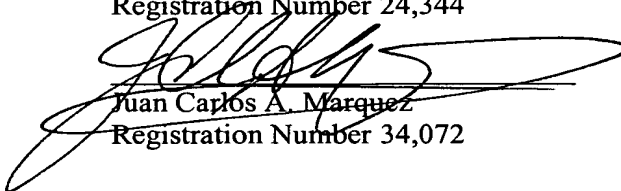
#### Conclusion

Applicant believes this response to be a full and complete response to the Office Action. Accordingly, favorable reconsideration in view of this response and allowance of the pending claim(s) are earnestly solicited.

If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the present application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,

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